

~~[or] and clearing said at least one receiver specific datum from a memory in response to said at
least one instruct signal.~~

25. (Amended) The method of claim 7, wherein said at least one [or more] output

device[s] includes a television monitor and said interactive image output apparatus receives

67
could
[some] a portion of a television program, said method further comprising the steps of:

selecting and passing said [some] portion of a television program to the television

monitor for delivery to a user;

generating [the] a balance of a series of complete video images for said television

program; and

synchronizing [the] delivery of said generated balance [of a series of complete video
images] at said television monitor based on said schedule.

II. REMARKS

A. Introduction

The Office Action dated February 3, 1998 has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 2-7, 9-11, and 13-25 are amended. Claims 2-25 are pending in the application.

Claims 2-25 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one

skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 4-6 and 19-21 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 3 and 18 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by USP 4,630,108 to Gomersall, hereinafter Gomersall '108.

Claims 2, 9, 11, and 13 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over GB 2,140,963 to Wine, hereinafter Wine '963.

Claims 2 and 8-14 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over USP 4,742,516 to Yamaguchi, hereinafter Yamaguchi '516.

Claims 7 and 22-25 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over USP 4,413,281 to Thonnart, hereinafter Thonnart '281.

Claims 2-25 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

B. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.

Applicants respectfully traverse the requirements of the Office Action paragraph 5.

Paragraph 5 of the Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (B) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully
Promulgated Substantive Rule Outside the
Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. Animal Legal Defense Fund v.

Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).¹ Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 CFR § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

¹ Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

a. **The PTO Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)**

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 CFR § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).² These two well established types of double patenting use an objective standard to determine when they are appropriate³ and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327

²MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

³ The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

compending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

**b. The New Requirement is Also a Substantive Rule
Because it Adversely Impacts the Rights and
Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the

applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

c. Conclusion: Substantive Rule

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or

(3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.

In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Office Action's result of abandonment of Applicants' application is legally untenable.

5. Response to Apparent Conflict of Claims

Applicants submit that the presentation of the Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

6. Request for Withdrawal of Requirement

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the

fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

7. Filing of Supplemental Oath

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

C. Information Disclosure Statement

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 9/12/95, 12/11/95, 2/6/95, 4/17/96, and 4/7/97 and have addressed those specific concerns raised in paragraph 6 of the Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
 - (2) foreign language references cited without a statement of relevance or translation
- have not been considered,

- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

1. Reason for Citation of Large Number of References

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

“[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants’ position is that information that was considered material in previous litigation would fall into the ‘variety of reasons’ category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

2. Citations of Foreign Language References

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, “[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance.” The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

3. References in the Information Disclosure Statements Subsequent to Applicants’ Latest Effective Filing Date of 9/11/87

Examiner stated “[n]umerous references listed in the IDS are subsequent to the applicant’s latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear.” Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants’ understanding that the effective filing date for the present application is **9/11/87**.

4. Citation of Unrelated References

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

5. Citation of Database Search Results

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

D. Response to Rejections under 35 U.S.C. § 112

1. Specification Support of Claims 2-25

Paragraph 7 of the Office Action rejects claims 2-25 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Office Action specified essentially all of the language of claims 2-25 as not being supported by the specification as originally filed.

The following tables list Applicants' claim language in the left column which corresponds to the specification support in the right column.

a. Claim 2

A method of controlling the outputting of mass medium program material at a subscriber station, said subscriber station including an output device, a memory, a receiver, and a processor, wherein said output device is capable of presenting mass medium program material, said receiver has a signal output coupled as an input to the processor, said processor has an output operatively connected to a control input of said memory, and said memory is operatively connected to said output device for communicating mass medium program material to said output device, said method comprising the steps of:	Page 534 lines 1-4 Fig. 7, including for example, #202, #217, and #222 #205 #258 #259 #258
storing mass medium program material and [one or more] subscriber data, said [one or more] subscriber data designating a subject of interest of a subscriber	For example, page 553 line 34 to page 554 line 2, including "record" at line 554 line 1. For example, page 340 line 12 and 34 and page 347 lines 3-5.
receiving an instruct-to-generate signal	For example, page 451 line 7 and 9. For example, page 548 lines 1-5.
generating a schedule by processing said [one or more] subscriber data in response to said instruct-to-generate signal	For example, page 548 lines 3-5 with page 551 lines 15-18 and, for example, page 551 lines 30-33.
controlling said memory to communicate mass medium program material to said output device in accordance with said schedule	Page 554 lines 7-10. Page 554 line 11.
presenting said communicated mass medium program material at said output device	Page 552 lines 2-5 with Page 20 line 16-19.

b. Claim 3

receiving at said subscriber station <u>at least one</u> [or more] instruct signal[s] which [are] <u>is</u> used to generate a schedule and output mass medium program material in accordance with said schedule	Page 548 lines 1-5 and page 542 lines 24-30. Page 551 lines 15-18, page 554 lines 10-11, and page 555 line 2.
generating [one or more] subscriber specific data, said generating at said subscriber station directed by instructions from said <u>at least one</u> [or more] instruct signal[s];	Page 548 lines 18-22, page 550 line 30 to page 551 line 6, page 554 lines 32-34.
receiving <u>one of</u> a viewer's [or] <u>and a</u> participant's response to a combined medium presentation at said subscriber station, said combined medium presentation including said mass medium program material	Page 555 lines 1-23 Page 555 lines 14-17 with page 555 lines 2-5 Page 2 lines 8-19 Page 555 line 2, page 340 line 34
transferring [one or more] <u>said</u> subscriber specific data from said subscriber station to <u>at least one</u> [or more] remote station[s] based on said step of receiving [a viewer's or participant's response].	Page 555 lines 22-29 with page 551 lines 11-14.

c. Claim 4

A method of controlling a remote intermediate [data] transmitter station to communicate [data] <u>at least one instruct signal</u> to <u>at least one</u> [or more] receiver station[s, with], said remote intermediate [data] transmitter station including <u>one of</u> a broadcast [or] <u>and a</u> cablecast transmitter [for transmitting one or more signals which are effective at a receiver station to instruct a computer or processor], a plurality of selective [transmission] <u>transfer</u> devices each operatively connected to said <u>one of said</u> broadcast [or] <u>and said</u> cablecast transmitter [for communicating a unit of data], a	For example, page 540 lines 11-13 with page 23 lines 24-26. Page 535 lines 18-23 and Fig. 6A & 6B including page 324 lines 11-17/page 325 lines 1-4. For example, #73, #75, #76
---	---

<p>[data] receiver for receiving said at least one instruct signal from at least one origination transmitter, a control signal detector, and one of a controller [or] and said computer for [capable of] controlling at least one [or more] of said plurality of selective [transmission] transfer devices, and with said remote intermediate [data] transmitter station adapted to detect the presence of at least one [or more] control signal[s], to control the communication of [specific] said at least one instruct signals in response to [detected specific] said control signals, and to deliver at [its] said broadcast or cablecast transmitter said at least one [or more] instruct signal[s], said at least one [or more] instruct signal[s] being effective at said receiver station to generate a schedule and [to] output mass medium program material in accordance with said schedule, said method [of controlling] comprising the steps of:</p>	<p>#57 or #73</p> <p>#71 or #73 #73</p> <p>Page 342 line 28 and/or page 345 lines 33-35.</p> <p>For example, page 539 lines 25-33.</p> <p>Page 539 lines 9-11.</p>
---	--

d. Claim 5

<p>comprising the step of embedding a specific at least one [of said one or more] control signal[s] in one of said at least one [or more] instruct signal[s] or in and an information transmission containing said at least one [or more] instruct signal[s] before transmitting said at least one [or more] instruct signal[s] to said remote intermediate [data] transmitter station.</p>	<p>Page 539 line 21.</p> <p>Page 539 line 21/page 540 line 19.</p> <p>Page 542 lines 23-26.</p> <p>Page 539 lines 8-11.</p>
---	---

e. Claim 6

<p>said specific time is a scheduled time of transmitting one of said at</p>	<p>Page 546 line 17 with page 340 lines 11-27.</p>
--	--

<p><u>least one</u> [or more] instruct signal[s or some] <u>and</u> information associated with said <u>at least one</u> [or more] instruct signal[s] from said remote intermediate [data] transmitter station, <u>wherein</u> [and] said <u>at least one</u> [or more] control signal[s are] <u>is</u> effective at said remote intermediate [data] transmitter station to control [one or more of] said plurality of selective [transmission] <u>transfer</u> devices at different times.</p>	<p>Page 342 lines 26-31 and page 326 lines 29-31.</p> <p>Page 347 lines 2-5.</p> <p>Page 367 lines 2-9.</p>
---	---

f. Claim 7

A[n interactive] method for information delivery for use with an interactive image output apparatus	<p>Page 8 lines 21-26 and for example page 312 lines 6-8, page 449 lines 26-35.</p> <p><u>Interactive</u>: "to act upon one another."</p>
outputting a first sequence of images that <u>one of</u> contains [or] <u>and</u> explains at least one receiver specific datum;	<p>Page 552 lines 15-30, including "in the fashion of example #10" at line 20 and "is explained" at line 28. For example, page 490 lines 20-23 and page 491 lines 11-16. For example, page 494 lines 33-35 and page 496 lines 15-27.</p>
making an offer during said first sequence of images for input [in] <u>with respect</u> [of] <u>to</u> said information;	<p>For example, page 494 line 33 with page 535 line 32 to page 536 line 2 and page 556 lines 14-18.</p>
receiving input from said subscriber at said input device in response to said offer, said interactive image output apparatus having a transmitter for communicating data to a remote site	<p>Page 555 lines 14-24.</p> <p>Page 33 lines 11-12.</p>
communicating said data to said remote site, said interactive mass medium output apparatus and said remote site comprising a network having a plurality of transmitter stations	<p>Page 555 line 25 to page 556 line 16.</p> <p>For example, page 556 lines 1-2.</p> <p>For example, page 535 lines 18-22 and page 534 lines 1-4 with page 33 lines 11-12.</p>
<u>one of</u> generating [or] <u>and</u> assembling, in said network, <u>at least one</u> [or more] message[s] which operate at said interactive image output apparatus to generate	<p>Page 547 lines 19-26 with page 371 line 11 to page 372 line 6. See also, page 37 lines 22-25.</p> <p>Page 548 lines 1-5.</p>

a schedule and to output a second sequence of images in accordance with said schedule, said interactive image output apparatus having a receiver for receiving a signal from [a] <u>said</u> remote station; and	Page 551 lines 15-18, page 554 lines 10-11, and page 555 lines 2-4.
delivering said information [at said one or more] <u>to said at least one</u> output device[s on the basis of said] <u>based on said at least one</u> [or more] message[s].	Page 555 lines 2-5 with, for example, page 552 lines 20-24.

g. Claim 9

[re]programming one of said memory and said processor based on information contained in said instruct-to-generate signal;	Page 548 lines 1-4 with, for example, page 484 lines 7-10.
interconnecting a plurality of devices at said subscriber station to process and display information <u>one of</u> contained in [or] <u>and</u> communicated with said mass medium program material based on said instruct-to-generate signal;	Page 553 lines 19-22, page 553 line 33 to page 554 line 3, page 555 lines 2-4. Page 554 lines 10-11 with page 551 lines 15-18.
controlling a decryptor in accordance with information contained in one of said instruct-to-generate signal and said mass medium program material;	Page 548 line 35 to page 549 line 4.
generating <u>at least one</u> [or more] of a subscriber budget, financial analysis, recommended plan, and solution to a problem in accordance with said [one or more] software and data modules; and	Page 548 lines 18-19 Page 550 lines 30-32, page 555 line 8 Page 543 line 33 with page 550 line 1 Page 548 lines 20-21 Page 365 lines 2-24 and page 16 lines 23-24
using linear programming techniques, in accordance with said instruct-to-generate signal, to value information contained in said mass medium program material.	Page 549 line 32 to page 550 line 1 Page 551 lines 26-30

h. Claim 10

analyzing said [one or more] subscriber data to value	Page 551 lines 26-30.
---	-----------------------

information contained in said mass medium program material;	
---	--

i. Claim 13

generating output information content by processing said one or more subscriber data in response to said instruct-to-generate signal; and	Page 548 lines 19-22 Page 550 lines 2-8
outputting <u>one of</u> a combined [or] <u>and a</u> sequential presentation of said mass medium program material and said generated output information content	Page 552 lines 20-30 including "in the fashion of example #10" at line 20 with, for example, page 491 lines 10-16 or page 491 lines 33-35, page 492 line 30, and page 493 lines 16-21.

j. Claim 15

Print	Page 552 line 24 and 29
At least one cost/benefit datum	For example, page 555 lines 8-12.
A value of said product service	Page 551 lines 28-34.

k. Claim 16

television programming and said subscriber station presents at least [some] <u>a portion</u> of said mass medium program material at said output device <u>one of</u> simultaneously [or] <u>and</u> sequentially with said television programming	Page 552 lines 20-23, including "in the fashion of example #10 at line 20" with, for example, page 491 lines 10-16 or page 491 lines 33-35, page 492 line 30, and page 493 lines 16-21.
--	---

l. Claim 17

The step of controlling a portion receiver to receive and communicate an expanding and contracting code portion to said detector	Page 460 lines 12-19 with page 35 lines 8-12 Page 462 lines 6-12.
--	--

m. Claim 18

storing <u>one of</u> meter information [or] <u>and</u> monitor information evidencing [said step] <u>processing</u> of [executing] said software module, said <u>one of said</u> meter information [or] <u>and said</u> monitor information [to be] <u>is</u>	Page 549 lines 19-21.
--	-----------------------

communicated to said <u>at least one</u> [or more] remote station[s].	
--	--

n. Claim 19

communicating to said [one or more] origination transmitter[s] a second control signal, said second control signal operative at said one of said remote intermediate [data] transmitter station and said receiver station to assemble said at least [some] <u>a portion of said at least one</u> [or more] instruct signal[s].	For example, page 54 lines 2-8. For example, page 23 line 35 to page 24 line 21 with page 37 lines 22-25. For example, page 344 lines 23-29, page 347 lines 3-5, page 356 lines 28-34, page 359 line 14 to page 360 line 1, page 363 line 34 to page 365 line 21.
--	--

o. Claim 20

wherein said mass medium program material [is] <u>includes</u> video, said specific time is a time to output said video according to said generated schedule, higher language code contained in said <u>at least one</u> [or more] instruct signal[s] is assembled at one of said remote intermediate [data] transmitter station and said receiver station, [and] <u>wherein</u> said <u>at least one</u> [or more] instruct signal[s are] <u>is effective at</u> said receiver station to modify a sequence of images in said video based on said schedule	For example, page 552 lines 20-24 For example, page 54 lines 7-11 or page 555 lines 2-5 or page 546 lines 16-17. Page 363 line 25 to page 365 line 21. Page 37 lines 22-25. Page 490 line 35 to page 491 line 16, page 506 lines 18-21.
---	---

2. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 4-6 and 19-21 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

Claim 4 has been amended to overcome the 112 rejection. Applicants submit that the above specification support and the amendments meet the office action's requirements.

3. Conclusion

Applicants respectfully submit that the claims of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 USPQ2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

E. Response to Rejection of Claims for Absence of Novelty

Applicants further respectfully submit that claims in the present application should be allowed because these methods are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim

negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986).

1. 35 U.S.C. § 102 (b) Rejection over Gomersall '108

Claims 3 and 18 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by USP 4,630,108 to Gomersall, hereinafter Gomersall '108.

With respect to claim 3, Gomersall '108 fails to teach, *inter alia*, receiving at said subscriber station at least one instruct signal which is used to generate a schedule and output mass medium program material in accordance with said schedule. In contrast, Gomersall '108 teaches that computer 64 receives telephonic instructions in advance from the local computer 12 and stores these telephonic instructions. col. 7 lines 4-6. Gomersall '108 is silent as to these telephonic instructions being capable of generating a schedule. In fact, the telephonic instructions normally include a substitute programming schedule for a substantial portion or all of an entire broadcast day or for a longer period, including the approximate tie of each substitute programming event. col. 7 lines 7-11. Applicants conclude that Gomersall '108 telephonic instructions already include a schedule. There is no concept in Gomersall '108 of at least one instruct signal which is used to generate a schedule and output mass medium program material in accordance with said schedule. Further, Gomersall '108 also teaches a special television signal that includes substitute programming signals and digital data in the form of substitute programming control signals and associated data, wherein a decoder 60 is used for separating the audio and video program information portions of the substitute programming signal from the digital data which includes, for example, the current time and the telephone number of the local computer 12 and test marketing questions, etc. col. 5 lines 14-17 and col. 6 lines 39-47. Again, there is no mention of any instruct signals that is used to generate a schedule and output mass medium program material in accordance with said schedule.

Further, Gomersall '108 fails to suggest or describe generating subscriber specific data, said generating at said subscriber station directed by instructions from said at least one instruct signal. Gomersall '108 does teach a number of ways in which a household member responds to the marketing research tests. However, none of the disclosed responses anticipate Applicants claimed generating subscriber specific data, said generating at said subscriber station directed by instructions from said at least one instruct signal. For example, Gomersall '108 teaches that a household member makes manual entries in a diary and later mails the diary to a central office. col. 7 lines 37-46. The household member may use a UPC scanner to optically scan the UPC code on any purchased retail items, as taught by Gomersall '108. col. 7 lines 49-58. Finally, the household may be equipped with a keyboard for entering numeric or alphanumeric representations of retail purchases and answers to the marketing test questions into computer 64 to be transmitted to local computer 12. In either case, none of the data is generated as directed by instructions from at least one instruct signal which is used to generate a schedule and output mass medium program material based on the generated schedule.

Further, Gomersall '108 fails to suggest or describe receiving one of a viewer's and participant's response to a combined medium presentation at a subscriber station, said combined medium presentation including said mass medium program material. Although, Gomersall '108 teaches receiving a household members response to certain test question and information on purchased items. There is no concept that the entries are in response to a combined medium presentation including the mass medium program material which is outputted in accordance with the schedule. In fact, nothing in Gomersall '108 suggests combined medium programming [see '87 specification at page 2 lines 8-19 and page 19 line 5 to page 28 line 4.

Therefore, since Gomersall '108 fails to suggest or describe Applicants' claimed receiving one of a viewer's and participant's response to a combined medium presentation at a subscriber station, then clearly there is no concept of transferring said subscriber specific data from said subscriber station to at least one remote station based on the step of receiving. Gomersall '108 fails to anticipate Applicants' claimed invention.

Claim 18 depends upon independent claim 3. As discussed *supra*, Gomersall '108 fails to disclose every element of claim 3 and thus, *ipso facto*, Gomersall '108 fails to anticipate dependent claim 18, and therefore, this rejection should be withdrawn and the claim be permitted to issue.

Applicants respectfully submit that the cited art does not anticipate claims 3 and 18 since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claims 3 and 18 be withdrawn.

F. Response to Obviousness Rejection of Claims

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 706.02(j).

1. 35 U.S.C. § 103 (a) Rejection over Wine '963

Claims 2, 9, 11, and 13 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over GB 2,140,963 to Wine, hereinafter Wine '963.

With respect to Applicants' amended claim 2, Wine '963 fails to, *inter alia*, teach or suggest all the claim recitations, i.e., storing said mass medium program material and subscriber

data, said subscriber data designating a subject of interest of a subscriber. The office action equates disc record 12 as “said memory (12) for storing a plurality of video program segments representing displayable “mass medium” video program material...along with...”subscriber selection data.” Applicants disagree and submit that the record disc 12 is simply for use in a video disc player for displaying programs. There is no concept of storing subscriber data on the disc. Instead, the subscriber simply selects a displayed video and its sequence. Wine '963 is completely silent as to storing said subscriber data, said subscriber data designating a subject of interest of a subscriber.

Further, Wine '963 is silent as to generating a schedule by processing said subscriber data in response to said instruct-to-generate signal. Although, Wine '963 teaches instructions being provided to the system from an external source, e.g., a viewer. There is no concept of receiving an instruct to generate signal and generating a schedule by processing said subscriber data in response to said instruct-to-generate signal. The instructions of Wine '963 are used as means of displaying a single program and its sequence as chosen by the viewer. Further, Wine '963 teaches the use of control signal, but the signals are only used as a means of controlling a kicker so that a transducer follows a predetermined path along the spiral track of the record disc. Again, there is no concept of generating a schedule by processing said subscriber data in response to said instruct-to-generate signal. Further, the office action equates the “dancing routine” of Wine '963 to Applicants’ generated schedule. Applicants respectfully disagree and submit that the “dancing routine” is simply the path that the stylus follow along the disc, which is clearly not any type of schedule. In addition, Wine '963 is completely silent as to any schedule being generated by processing subscriber data.

Therefore, since there is no concept of any generated schedule in Wine '963, clearly there is no teaching of controlling said memory to communicate mass medium program material to said output device in accordance with said schedule and presenting said communicated mass medium program material at said output device.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 2 be withdrawn.

Claims 9, 11, and 13 depend upon independent claim 2. As discussed *supra*, Wine '963 fails to disclose every element of claim 2 and thus, *ipso facto*, Wine '963 fails to anticipate dependent claims 9, 11, and 13, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

2. 35 U.S.C. § 103 (a) Rejection over Yamaguchi '516

Claims 2 and 8-14 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over USP 4,742,516 to Yamaguchi, hereinafter Yamaguchi '516.

With respect to Applicants' amended claim 2, Yamaguchi '516 fails to, *inter alia*, teach or suggest all the claim recitations, i.e., receiving an instruct-to-generate signal and generating a schedule by processing said subscriber data in response to said instruct-to-generate signal. The office action states that the accessing the memory of Yamaguchi '516, "by definition, represents a display or output schedule." Applicants respectfully disagree and submit that the information which is stored, i.e., the information packets with the classification codes, distinction codes, and the texts, are not processed based on any schedule. In fact, the text, which is the only information that is read out of the memory, is done so when a "receiver gives the receiving set an output order at his or her convenient time." col. 9 lines 31-32. Yamaguchi '516 does not teach

generating a schedule in response to an instruct-to-generate signal, because the text is processed and output based on the convenient time of the receiver.

Further, the office action equates the output order with Applicants claimed instruct-to-generate signal. Again, Applicants respectfully disagree and submit that Yamaguchi's output order is input by the receiver by turning a switch in order to read out the text accumulated in the accumulator in succession. There is no concept of generating a schedule by processing said subscriber data in response to said instruct-to-generate signal. Instead, the output order simply allows the scanning device to read the text in succession. Yamaguchi '516 is completely silent as to any generated schedule in response to any instruct-to-generate signal.

Therefore, since Yamaguchi '516 fails to suggest or describe a schedule that functions as Applicants' claim, then clearly there is no concept of controlling said memory to communicate mass medium program material to said output device in accordance with said schedule and presenting said communicated mass medium program material at said output device. Again, Yamaguchi '516 simply reads the text once the receiver enters the output order, not based on a schedule, but at their own convenient time. Yamaguchi '516 fails to anticipate Applicants' claimed invention.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 2 be withdrawn.

Claims 8-14 depend upon independent claim 2. As discussed *supra*, Yamaguchi '516 fails to disclose every element of claim 2 and thus, *ipso facto*, Yamaguchi '516 fails to anticipate dependent claim 8, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

3. 35 U.S.C. § 103 (a) Rejection over Thonnart '281

Claims 7 and 22-25 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over USP 4,413,281 to Thonnart, hereinafter Thonnart '281.

With respect to Applicants' amended claim 7, Thonnart '281 fails to, *inter alia*, teach or suggest all the claim recitations, i.e., outputting a first sequence of images that one of contains and explains at least one receiver specific datum. The office action equate the components of Fig. 3 as teaching Applicants' claimed outputting step. Applicants respectfully disagree and submit that although Thonnart '281 alludes to the transmission of the entirety of information and the transmission of teletext relative to an image. There is no specific teaching of outputting a first sequence of images that one of contains and explains at least one receiver specific datum. Again, Thonnart '281 suggests successive reproduction of text, images, and voice commentaries, for example within an education program, wherein he succession depends on the progress of the students. However, there is no suggestion of outputting anything that either contains or explains a receiver specific datum. Instead, Thonnart '281 teaches the transmission of information coded in a digital form wherein the texts transmitted in digital form are accompanied by messages in analog from representing images or commentaries. Thonnart '281 is silent as to outputting a first sequence of images that one of contains and explains at least one receiver specific datum.

Further, Thonnart '281 fails to suggest or describe making an offer during said step of outputting with respect to said information. Again, Thonnart '281 briefly mentions an interactive education program. However, there is no mention or inherent teaching of making an offer. Thonnart '281 is completely and utterly silent as to making any offer.

Therefore, Thonnart '281 fails to suggest or describe receiving input from said subscriber at said input device in response to said offer. Again, Thonnart '281 briefly mentions an

interactive education program. However, there is no mention or inherent teaching of making an offer or receiving input in response to said offer.

Further, Thonnart '281 fails to suggest or describe one or generating and assembling, in said network, at least one message with operates at said interactive image output apparatus to generate a schedule and to output a second sequence of images in accordance with said schedule. Instead, Thonnart '281 teaches an identifying message which completely the recording in the memory of an image. There is no teaching in Thonnart '281 of any message that is assembled or generated to function as Applicants' claim. Therefore, Thonnart '281 fails to suggest or describe delivering said information to said at least one output device based on said at least one message. Thonnart '281 fails to anticipate Applicants claimed invention.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 7 be withdrawn.

Claims 22-25 depend upon independent claim 7. As discussed *supra*, Thonnart '281 fails to disclose every element of claim 7 and thus, *ipso facto*, Thonnart '281 fails to anticipate dependent claims 22-25, and therefore, this rejection should be withdrawn and the claim be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

4. No Prior Art Rejection

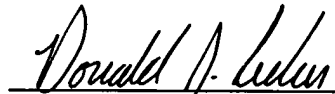
Claims 4-6 and 15-21 have not been rejected over the prior art of record. Applicants contend that the claims will be allowable upon withdrawal of the 112, first and second paragraph rejections.

III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Respectfully submitted,



Thomas J. Scott, Jr.
Reg. No. 27,836
Donald J. Lecher
Reg. No. 41,933
Attorney for Applicants
Tel: (202) 383-6790

Date: August 3, 1998
HOWREY & SIMON
1299 Pennsylvania Avenue, NW
Washington, D.C. 20004